

Remarks

In response to the Office Action dated August 10, 2007, Applicant respectfully requests reconsideration based on the following remarks. Applicant respectfully submits that the claims as presented are in condition for allowance. Claims 1, 17 and 20 have been amended to clarify that the request is being received via e-mail.

Interview Summary

A telephone interview was conducted on October 23 between the undersigned and Examiner Dorno. During the interview several Office Action errors and ambiguities were discussed for clarification. For example, the Office Action makes a concession on page three then cites Desai in support of the very same point on page 4 although misidentified as being described in Matsuo.

It was further discussed that in regard to the Desai reference that the Office Action is equating the recited "private database" to the profile information accessed through the Information Request Review Subsystem.

Claim Rejections - 35 U.S.C. §103

Claims 1-3, 8 and 12-19 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Desai (U.S. Pat. 6,820,204) in view of Matsuo (U.S. Pat. App. 20030130857) and further in view of Hill (U.S. 6,029,192). Claim 20 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Matsuo (U.S. Pat. App. 20030130857) in view of Hill (U.S. 6,029,192). Claims 9-11 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Hill in view of Birrell (U.S. Pat. 6,185,551).

As mentioned in the Interview Summary, the Office Action contained several material errors. As per Examiner Dorno, the following should be corrected: in Paragraph 4, the term "receiving" in bold type should read "retrieving"; on Page 4, the second paragraph citing Matsuo should actually be referring to Desai; in regard to claim 17 the reference to BRECK should read DESAI; and in paragraph 6 the rejection is over the combination of Desai, Matsuo, Hill and Birrell and NOT over the combination of Hill and Birrell.

Claims 1-3, 8 and 12-19

The Office Action rejects amended independent claim 1 by asserting that Desai describes most of the claim's elements. However, the Office Action concedes that Desai fails to describe that [at an e-mail server] upon receiving the request [for information], compare[es] an e-mail address identified with the wireless communication device against a list of e-mail addresses residing at the e-mail server, and also fails to describe that if the identified e-mail address is on the list, then authorizing retrieval from the private database and further concedes that Desai fails to describe sending a query to retrieve the information [from the private database].

However, Applicant respectfully notes that in addition to the conceded deficiencies, Desai fails to describe additional subject matter asserted to Desai by the Office Action. For example, Desai also fails to describe *"at an e-mail server, receiving, via e-mail, a request from a wireless communication device to retrieve the information in the private database..."*

In its rejection, the Office Action explicitly cites **Figure 1, item 30 as equating to the recited e-mail server**. The Office Action also cites Column 22 l. 15-19 as describing "at an e-mail server, receiving a request from a wireless communication device to retrieve the information in the private database" where it is **expressly equating the personal profile to the private database**. However, Applicants completely disagree. Desai fails to describe that the request from a wireless communication device is received at an e-mail server.

In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. Each of the references and the claims must be considered as a whole. MPEP 2141.02. Taking each of the claim and the reference as a whole, Desai fails to describe **"...at an e-mail server, receiving via e-mail; a request from a wireless communication device to retrieve the information in the private database..."**

Desai describes utilizing a **web browser** (Col. 3, l. 53) to access the Information Exchange System 804/10 ("IES") which contains the Info Review Request Subsystem ("IRRS") 810. (FIG. 5; Col. 21, l. 56-Column 22, l. 22). The IRRS manages access to user profile information which the Office Action is expressly equating to the recited private database. The IRRS system allows a user to enter or edit profile information and manages requests to access the profile information including accepting and denying information requested of the user by others via the internet. (Col. 10, l. 20-30).

The IES/IRRS 810 is a web server, not an e-mail server, as it does not communicate with the user via e-mail but by a web browser. (Col. 3, l. 40-60). The IES/IRRS 810 is certainly not e-mail server 30 as specifically relied on by the Office Action. Because the Office Action is specifically citing e-mail server 30 as being the recited e-mail server, the Office Action is implicitly conceding that IES/IRRS 810 is not an e-mail server.

The IES/IRRS 10 has very little to do with the e-mail server 30. The e-mail server 30 is merely an **unaffiliated** data storage site (Col. 10, l. 43-50). The IES periodically accesses the e-mail server to determine if there is any new e-mail for the user. Therefore, Desai does not describe accessing the IRRS via e-mail, accessing the IRRS via a message with an e-mail address or accessing the IRRS “at an e-mail mail server”. For at least the same reasons, the IRRS also cannot be construed as an e-mail server. At most, Desai describes that the IRRS may download e-mail from the e-mail server 30 for access by the user over the web. (Col. 10, l. 54-62).

For at least the above reasons, Desai does not describe *at an e-mail server, receiving a request from a wireless communication device to retrieve the information in the private database*. As such, Desai fails to describe the subject matter asserted to Desai by the Office Action for at least this reason.

Further, amended independent claims 1, 17 and 20 now clarify that the request is received via e-mail. Desai specifically describes that the user access the IES/IRRS 810 via a web browser. As such, Desai fails to describe the subject matter asserted to Desai by the Office Action for at least this additional reason.

Matsuo is concerned with exchanging documents, e-mail and other electronic information. Matsuo describes an intermediary e-mail address on a network and a database also located somewhere on the network. (§ 0008). The database contains authorized sender information and user information. Matsuo describes that when an e-mail arrives at the intermediary e-mail address for the user, the sender e-mail address is compared to the user information in the database. If there is a match then the intermediary e-mail server **forwards the e-mail** to the user’s forwarding address. Applicants respectfully assert that Matsuo does not describe *at an e-mail server, receiving a request from a wireless communication device to retrieve the information in the private database*.

While Applicant does not concede to the correctness of such a construction, even if such a construction was proper, Matsuo still does not describe “at an e-mail server...receiving a

request from a wireless communication device to **retrieve** the information in the private database.” Matsuo is actually **sending** information to the “private database” after comparing the user information. Nothing is being retrieved from the forwarding e-mail address.

Alternatively, Matsuo also describes that a log file is located in the network database, that it records of all e-mail traffic sent to the user’s intermediary e-mail address database and that the user may access the log via a wireless communication device. (¶ 0009). If the “log” file located in the database, or the database itself, is being interpreted as the “private database”, then Matsuo still does not describe “at an e-mail server, receiving a request from a wireless communication device to retrieve the information in the private database.” There is no description in Matsuo that the database/log is located at, or is being accessed through, an e-mail server. Matsuo merely describes that the database may be accessed by the user over the network. There are numerous ways a database on a network may be accessed other than by an e-mail server. Therefore, for the above reasons, Matsuo fails to cure this deficiency of Desai.

Hill is concerned with locating and evaluating public internet resources. Hill does not describe “at an e-mail server, receiving a request from a wireless communication device to retrieve the information in the **private database**; upon receiving the request, comparing an e-mail address identified with the wireless communication device against a list of e-mail addresses residing at the e-mail server, and if the identified e-mail address is on the list, then authorizing retrieval from the **private database**...” As such, Hill fails to describe the deficiencies of the combination of Desai and Matsuo described above.

Because neither of Matsuo or Hill cures the above deficiencies of Desai, the Office Action has failed to establish a prima facie case of obviousness because the combination of Desai, Matsuo and Hill fails to describe all of the claim elements. Independent claims 16 and 17 recite similar subject matter and are therefore allowable for at least the same reasons. Claims 2-3, 8-16 and 18-19 depend from an allowable claim 1 or 17 and are therefore allowable for at least these same reasons.

Furthermore, the Office Action concedes that Desai fails to describe “[at an e-mail server]... sending a query to retrieve the information [from the private database].” Applicant agrees with the Office Action’s concession. Desai merely describes the e-mail server 30 as unaffiliated data storage. Taking the claim as a whole (MPEP 2141.02), nothing in Desai

describes the e-mail server 30 sending a query to retrieve the information from either the e-mail server 30 itself or from the profile database controlled by the IES/IRRS 10.

At most, Matsuo describes that the **user may access** the log in the database. Matsuo does not describe “[at an e-mail server]...sending a query to retrieve the information [from the private database]”. Such access/retrieval may be effectuated in many ways and does necessarily require an e-mail server sending a query to retrieve the information. As such Matsuo fails to cure this additional discrepancy in Desai.

Hill is concerned with locating and evaluating *public* internet resources. Hill does not describe “[at an e-mail server] sending a query to retrieve the information from the [*private*] database. As such, Hill also fails to cure the above deficiency of Desai.

Because none of Matsuo, Hill or their combination cures this additional deficiency of Desai, the Office Action has failed to establish a prima facie case of obviousness because the combination of Desai, Matsuo and Hill fails to describe all of the claim elements. Independent claim 1 is allowable for at least this additional reason. Independent claims 16 and 17 recite similar subject matter and are therefore allowable for at least the same reasons.

Because the Office Action has failed to establish a prima facie case of obviousness for each of the specific reasons discussed above, independent claims 1, 16 and 17 are allowable over the combination of Desai, Matsuo and Hill. Claims 2-3, 8-16 and 18-19 depend from an allowable claim 1 or 17 and are therefore allowable for at least the same reasons.

Claims 20

Amended claim 20 stands rejected under 35 U.S.C. §103(a) and being unpatentable over Matsuo in view of Hill. Applicants respectfully traverse the rejections.

Amended claim 20 recites, in pertinent part:

“[a] a computer readable medium having stored thereon a set of instructions which, when executed by a processor, cause the processor to... authorize via e-mail an e-mail server to retrieve information in a private database and forward the information to the wireless communication device...if the identified e-mail is on the list , then authorizing retrieval from the private database...”

The Office Action asserts that Matsuo describes most if the claim elements. In support of its assertion it cites paragraphs 0008-0009 and 0046. Applicants respectfully disagree. Matsuo

fails to describe authorizing an e-mail server to retrieve information in a private database and forward the information to the wireless communication device.

Matsuo describes creating an intermediary e-mail address where an intermediary e-mail may be sent and if the sender's e-mail address matches a stored e-mail address then forwarding the intermediary e-mail to the user's forwarding e-mail address. (§ 0008). If the Office Action is equating the intermediary e-mail as the information, then Matsuo is authorizing the e-mail server to forward information to a forwarding email address and is not authorizing e-mail server to retrieve information from the forwarding e-mail address to be sent to the wireless communication device. Alternatively, if the Office Action is equating the e-mail addresses stored in the database to the recited information then Matsuo is not authorizing the retrieval of the address to be forwarded to the wireless communication device. Matsuo is merely comparing the e-mail address to the sender address. The retrieved e-mail address is not sent anywhere. Therefore § 0008, and Matsuo in general, is not describing "...authorizing an e-mail server to retrieve information in a private database and forward the information to the wireless communication device...if the identified e-mail is on the list, then authorizing retrieval from the private database..."

Further, Matsuo describes that a record of each received e-mail addressed to the intermediary e-mail address of the user may be stored in a log in the database. The user may then be permitted to access the log in the database, via a wireless communication device, to review a record. (§ 0009). Paragraph 0009 is not describing authorizing an e-mail server to retrieve information in a private database and forward the information to the wireless communication device. The database log is not described as being accessible by an e-mail server. The database (and therefore the log) is merely described as being accessed by the network. The database may be accessed in any number of ways other than being retrieved by the e-mail server. Further, information from the log is not being described as being accessible only if the identified e-mail address is on the list. Therefore § 0008, and Matsuo in general, is not describing "...authorizing an e-mail server to retrieve information in a private database and forward the information to the wireless communication device...if the identified e-mail is on the list, then authorizing retrieval from the private database..."

For at least the forgoing reasons, Matsuo fails to describe the subject matter asserted to Matsuo by the Office Action. Hill is concerned with accessing public databases and therefore

does not cure the deficiencies of Matsuo. Therefore the Office Action has failed to establish a prima facie case of obviousness because the combination of Matsuo and Hill fails to describe each and every claim element. As such, independent claim 20 is allowable over the combination of Matsuo and Hill for at least these reasons.

Claim 9-11

Claims 9-11 stand rejected under Desai, Matsuo, Hill and further in view of Birrell. Claims 9-11 depend from an allowable independent claim 1 and share its features. As such, dependent claims 9-11 are allowable for at least the same reasons.

Conclusion

In view of the foregoing remarks, this application is now in condition for allowance. A notice to this effect is respectfully requested. If the Examiner believes, after this amendment, that the application is not in condition for allowance, the Examiner is invited to call the Applicant's attorney at the number listed below.

No Fees are believed due. However, please charge any additional fees due or credit any overpayment to Deposit Account No. 50-3025.

Date: November 07, 2007

Withers & Keys, LLC
P.O. Box 71355
Marietta, GA 30007-1355
(770) 518-9822

Respectfully submitted,

/Arno Naeckel/

Arno Naeckel #56114